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09/943,941	08/31/2001	Thomas Joseph Prorock	RPS920010141US1	2053
45503	7590	07/01/2005	EXAMINER	
DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759			CARLSON, JEFFREY D	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/943,941

Filing Date: August 31, 2001

Appellant(s): PROROCK, THOMAS JOSEPH

Antony P. Ng
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/13/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is acceptable.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Prior Art of Record*

6,070,147	Harms et al	5-2000
5,918,211	SLOANE	6-1999

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US5918211) in view of Harms et al (US6070147).

Regarding claims 1, 2, 10, 11, Sloane teaches a handheld scanner which is used to scan a user's card to determine the user's identity [3:32-41]. This is sent wirelessly to a remote host which looks up and transmits the user's account information to the display on the scanner. The scanner provides the status of the user's account such as available discounts, *credits*, rewards, etc stored in their account [9:5-20]. The scanner provides a running total and information regarding the current purchases as well as year-to-date savings [3:65-66]. As the user scans products throughout the store, the scanner will identify the products and their prices and will alert the user when a certain product is eligible for a promotion [3:12-23]. The customer is also alerted at the scanner device to available discounts, *credits*, rewards or promotions [3:39-41]. The user can

use the scanner buttons to add the product to his current product total [6:21-28]. The user can also display the current running balance on the products purchased [6:36-38]. Harms et al teaches the idea of accruing points by shopping and getting an award at a *particular plateau* for the loyalty point balance [fig 8a]. It would have been obvious to one of ordinary skill at the time of the invention for the host to have kept a running total of the loyalty points earned during the shopping trip and combined them with the loyalty credits previously earned so that the user is made aware of his current running loyalty balance -- much like Sloane's desire for notification of present purchasing status: current purchase information plus previously earned (i.e. stored) purchase information. It would have been obvious to one of ordinary skill at the time of the invention to have let the users know the defined plateau values (and optionally their current shortage), so that they are encouraged to make purchases in order to achieve the defined plateaus. Merely providing current balance and the defined plateau value(s) serves to effectively alert the users when they are within various thresholds/ranges from the predetermined plateaus as well as when they have reached the plateau. Optionally it would have been obvious to one of ordinary skill at the time of the invention to have done the simple arithmetic for the users so that they can determine their shortfall(s) with respect to the defined plateau(s).

Regarding claims 3, 4, 12, 13, Sloane teaches that the user can press a button to confirm the purchase of a scanned product [6:26-28]. The host cannot provide updated real-time balances (purchases, purchase amounts, loyalty balances) until the host is

made aware of the current scanned purchase which does not occur until the user confirms the purchase.

Regarding claims 9, 14, the device is portable.

(10) Response to Argument

Applicant argues that Sloane teaches only alerting the customer based on the product presently being scanned and does not rely on the user's fetched account information. This is why Examiner has modified Sloane with the teachings of Harms et al. However it is noted that Sloane does present the user with status information regarding current purchases plus previous, stored purchases – this provides motivation for providing old plus current loyalty point status information in order to keep the consumer up to date regarding his purchasing and loyalty status. Harms et al teaches awarding at a particular plateau of points which is also taken to have been an obvious modification. Of the rewarding mechanism.

Applicant argues that Sloane teaches influencing purchases before a user starts shopping. This point appears to be superfluous, especially given that Sloane also teaches influencing purchases as the user scans products with the mobile device (i.e. during shopping). It is also pointed out that Sloane's statement of influencing purchases at the "point of purchase" [col 1 lines 11-14 as pointed out by applicant] is clearly synonymous with doing so "in the store" – the user is alerted to promotions as products are scanned throughout the store by the consumer. Examiner's combination provides

loyalty status information as the consumer scans products throughout the store – in much the same way as applicant's claims.

Applicant argues differences between Sloane and Harms et al as reasons against combining them. First - that Harms et al does not influence purchases at the point of purchase. This is clearly taught by the base reference, Sloane which is modified by Harms et al; Harms et al need not include such a feature. Second, applicant states in the brief that Examiner supposedly agrees that Harms et al does not intend to influence purchasing decisions. Examiner did not make such a statement – in fact, Harms et al's loyalty program (like any loyalty program) is designed to do just that – encourage particular purchasing behavior. Last – that Harms et al teaches different point awarding criteria (number of purchases or visits in a given time) and different reward fulfillment mechanisms (mailing reward or issuing reward at the POS). Although the references have their differences, they each are directed to loyalty programs and are strongly related to applicant's field of endeavor and are suitable for a 103 combination.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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jdc
June 23, 2005

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